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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,307

07/15/2003

Humberto Herrera

HERH-002

7543

7590

06/28/2005

Intellectual Property Development

Jack J'maev

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EXAMINER

BUGG, GEORGE A

ART UNIT

PAPER NUMBER

2636

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,307

Applicant(s)

HERRERA ET AL.

Examiner

George A. Bugg

Art Unit

2636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/04/2005 have been fully considered but they are not persuasive. Explanation and art rejection to follow.
2. With regard to claims 1-17, particularly the independent claims 1, 5, and 11, Applicant's amendment has not cured the deficiencies with regard to the indefiniteness of these claims. As for claim 1, the Examiner would like to emphasize, that the installation of the disablement system, while a government required inspection is being performed, is not critical to the functionality of the disablement system. Said system could be installed during the manufacture of the vehicle, during a routine oil change, or installed by a private end user of the vehicle. The time of installation is not patentably distinct. The method of installation should include details concerning the installation process, such as electrical connections and/or mechanical connections, not where and when. In addition, claims 5, 11, and 17 are still unclear. A suggested fix may be the following:disable the vehicle "when a **disablement** radio signal is received, **or in the absence of receiving any radio signal by the radio signal receiver.**
3. Applicant further argues that the Musie reference and the Delany reference are non-analogous art, and that there is no motivation to combine. On the contrary, both references deal with systems related to motor vehicles, and therefore belong to related fields of endeavor.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As stated above, with respect to claim 1, the Examiner would like to emphasize, that the installation of the disablement system, while a government required inspection is being performed, is not critical to the functionality of the disablement system. Said system could be installed during the manufacture of the vehicle, during a routine oil change, or installed by a private end user of the vehicle. The time of installation is not patentably distinct. The method of installation should include details concerning the installation process, such as electrical connections and/or mechanical connections, not where and when. In addition, claims 5, 11, and 17 are still unclear. A suggested fix may be the following:disable the vehicle "when a **disablement** radio signal is received, **or in the absence of receiving any radio signal by the radio signal receiver.**

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent

No. 4,854,144, to Davis.

8. With respect to claim 1, column 1, lines 33-35, disclose applying the boot to prevent unauthorized operation of vehicle, and can quickly and easily be applied by parking officials or law enforcement. In the broadest interpretation of claim 1, a government required inspection, as related to Davis, could be patrolling parking areas for illegally parked cars, and installing the disablement system, in this case the boot, to disable operation of the car.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,072,248 to Muise et al., in view of US Patent No. 5,918,256 to Delaney et al.

11. With respect to claims 1 and 2, Applicant claims a method for installing a vehicle disablement system, wherein the system is installed while a vehicle is undergoing a

government required inspection, such as an emission control inspection. Column 4, line 10 through column 5, line 4, disclose several different methods for installing the vehicle disablement system, disclosed by Muise, such as factory installation, retrofitting, as well as an alternative installation method for older model vehicles. While the Muise reference is silent with respect to installing the system during a government required inspection, column 1, lines 14-27, of the Delaney reference disclose that it is well known that various US states, as well as foreign countries, require periodic emission testing, and that the testing is carried out in facilities which can accommodate a large number of vehicles. Therefore, it would have been obvious to one of ordinary skill in the art to install the system during the inspection process, for the purpose of minimizing a driver's off-road time, as well as having the work performed by a licensed automotive technician.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,072,248 to Muise et al., in view of US Patent No. 5,918,256 to Delaney et al. as applied to claims 1 and 2 above, and further in view of US Patent No. 6,371,000 to Hutmacher et al.

13. With respect to claim 3, while the Muise-Delaney combination do not specifically disclose a border crossing inspection, the Hutmacher reference (column 1, 11-43) the need for a disablement system, particularly when vehicles run roadblocks, toll booths, checkpoints, or inspection points. It is therefore the contention of the Examiner, that it would have been obvious to one of ordinary skill in the art, to install a disablement

system at the time of a border inspection, for the purpose of insuring future law enforcement control, as well as avoiding high-speed chases.

14. With respect to claim 4, column 3, lines 38-59, of the Muise reference, discloses a receiver being connected to an engine control module (ECM), or a receiver being connected to a vehicle computer. This citation also teaches that when the receiver receives signal T, from police, that the ECM sends a signal to the fuel pump to initiate slow-down, and/or stall. The ECM is thereby programmed to respond to a signal for the purpose of disabling the vehicle.

15. As for claim 5, column 3, lines 38-59, of the Muise reference, discloses a receiver being connected to an engine control module (ECM), or a receiver being connected to a vehicle computer. This citation also teaches that when the receiver receives signal T, from police, that the ECM sends a signal to the fuel pump to initiate slow-down, and/or stall. The ECM is thereby programmed to respond to a signal for the purpose of disabling the vehicle. In addition, the Hutmacher reference teaches (column 4, lines 1-7) that his disablement system can be used to turn off any source of mechanical power that relies on electrical signals, such as and electronic ignition.

16. With regard to claim 8, Muise teaches in column 4, lines 41-46, incorporating the receiver into the computer.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George A Bugg whose telephone number is (571) 272-2998. The examiner can normally be reached on Monday-Thursday 9:00-6:30, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George A Bugg
Examiner
Art Unit 2636

June 21, 2005



JEFFERY HOFSSASS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600